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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC JONSEN

Appeal 2009-008827
Application 10/573,065
Technology Center 3700

Decided: November 30, 2009

Before: WILLIAM F. PATE III, LINDA E. HORNER and KEN B.
BARRETT, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 1-20. App. Br. 3. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

THE INVENTION

The Appellants' claimed invention is directed to an apparatus and method for identifying an electrode type in an automatic external defibrillator. Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for identifying an electrode type in an automatic external defibrillator comprising the steps of:

providing on an automatic external defibrillator electrode package which includes an electrical connector for coupling an electrode to the defibrillator a shaped conductive label having a conductive path that uniquely identifies a type of electrode contained therein;

coupling the electrode electrical connector to an electrode connector of the defibrillator; and

coupling one or more conductors to the shaped conductive label when the automatic external defibrillator electrode package is coupled to the defibrillator.

THE EVIDENCE

The Examiner relies upon the following evidence:

Wheeler	US 5,989,053	Nov. 23, 1999
Verness	US 6,018,683	Jan. 25, 2000
Olson	US 6,101,413	Aug. 8, 2000

THE REJECTIONS

Claims 1-3, 5-7, 9, 12-17, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Olson. Ans. 3-6.

Claims 4, 8, 10, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Olson and Verness. Ans. 6-7.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Olson and Wheeler. Ans. 7.

OPINION

Regarding the rejection of each of the independent claims 1, 5, 6, and 16, the Examiner found that it would have been obvious to one of ordinary skill in the art to have considered Olson's identification element 400 within package 60 to be the claimed shaped label. Ans. 4, 8. Appellant contends that neither Olson's identifying means 400, nor any of the particular embodiments thereof, e.g., resistor 406, are reasonably construed as the claimed "shaped conductive label," nor would they have rendered such a structure obvious. App. Br. 8; Reply Br. 3.

"[T]he precise language of 35 U.S.C. § 102 that '(a) person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103." *In re Warner* 379 F.2d 1011, 1016 (CCPA 1967). A determination of anticipation, as well as obviousness, involves two steps. First is construing the claim, a question of law, followed by, in the case of anticipation or obviousness, a comparison of the construed claim to the prior art. This comparison process involves fact-finding. *Key Pharmaceuticals v. Hercon Labs. Corp.*, 161 F.3d 709, 714 (Fed. Cir. 1998) (citations omitted).

"[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be

afforded by the written description contained in applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 1185 (Fed. Cir. 1993). Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969).

The Specification provides that "[p]ins on the defibrillator body make electrical contact with the metallic label when the package is attached to the defibrillator. These pins sense the shape of the conductive label to ascertain the electrode type, thereby enabling the [automatic external defibrillator] to automatically sense the proper operating mode." Spec. 2:10-13. From the Specification one of ordinary skill in the art would understand the phrase "shaped conductive label having a conductive path that uniquely identifies a type of electrode" to mean a label wherein the shape of the label performs a role in that identification process.

Figure 9 of Olsen schematically illustrates a concept for detecting the presence of pediatric electrodes. Col. 7, ll. 65-67. An identification element 400 is placed in the electrode package 60 and included in an electrical circuit. Col. 8, ll. 4-8. Based upon a measured response, a processor 74 provided with the defibrillator can determine if electrodes 50 are pediatric electrodes. Col. 8, ll. 13-16. Olsen discloses that the identification element may be embodied as a resistor 406, or other passive or active component

such as an inductive or capacitive component or a memory chip or digital sensor. Col. 9, ll. 13-18, 32-34. Olsen does not teach that the disclosed identification means, or any embodiment thereof, is physically shaped in any particular way.

What a reference teaches a person of ordinary skill is not limited to what a reference specifically “talks about” or what is specifically “mentioned” or “written” in the reference. *Syntex (U.S.A.) LLC v. Apotex, Inc.* 407 F.3d 1371, 1380 (Fed. Cir. 2005). However, the key to supporting any prima facie conclusion of obviousness under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Federal Circuit has stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), cited with approval *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Although the device and method described by Olsen solves a similar problem in a similar fashion, this fact alone is not sufficient to establish that the claimed subject matter would have been obvious to one having ordinary skill in the art. There is no legally recognizable essential gist or heart of the invention. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548 (Fed.Cir.1983), *cert. denied*, 469 U.S. 851 (1984). All words in a claim must be considered in judging the obviousness of the claimed subject matter. *See In re Wilson*, 424 F.2d 1382, 1385. The Examiner’s conclusion that it would have been obvious to modify Olsen’s identification element to be a label with a particular shape does not rationally flow from the fact that Olsen

suggests the identification elements may be placed in alternate locations. Ans. 4; Olsen col. 8, ll. 26-34. Olsen does not teach or suggest that the shape of the identification element is of any particular importance, regardless of its location. The Examiner has failed to articulate a rational underpinning to support the legal conclusion of obviousness. We are therefore constrained to conclude that the Examiner improperly relied upon speculation and conjecture in determining that the subject matter of claims 1, 5, 6 and 16, and therefore dependent claims 2-4, 7-15 and 17-20, would have been obvious to one having ordinary skill in the art.

DECISION

For the above reasons, the Examiner's rejections of claims 1-20 are reversed.

REVERSED

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